BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

First Named Inventor	:	Jai RAWAT
Serial No.	:	09/846,741
Filed	:	May 1, 2001
Art Unit	:	2141
Confirmation No.	:	4472
Examiner	:	Kristie Shingles
Title	:	METHOD AND SYSTEM OF AUTOMATING DATA CAPTURE FROM ELECTRONIC CORRESPONDENCE
Attorney Docket No.	:	OBON0004

October 21, 2008

MAIL STOP: REPLY BRIEF - PATENTS
Honorable Commissioner of Patents & Trademarks
P.O. Box 1450
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REPLY BRIEF

Appellant's Reply Brief follows.

STATUS OF CLAIMS

The status of the claims is as follows:

Claims 1-10 are rejected. Each of these claims is on appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following ground for rejection is to be reviewed on appeal:

1.   Whether the subject matter of Claims 1-10 is anticipated by Sheldon *et al* (USPN 6,708,205) under 35 USC §102(e).

ARGUMENTS

A. The First Element of Claim 1 is Not Supported by the Provisional Application

The 35 USC 102(e) critical reference date of a U.S. patent is entitled to the benefit of the filing date of a provisional application if the application properly supports the subject matter relied upon to make the rejection in compliance with 35 USC 112, first paragraph. (MPEP 2136.03 III) Thus, the provisional must contain a written description in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the invention. (35 USC 112) Thus, the Examiner's assertion that the Sheldon patent "explicitly" teaches a system that distinguishes between commercial and non-commercial suffixes is irrelevant because the real question is whether the provisional enables the Sheldon patent by providing enough information to allow a person of ordinary skill in the art to make and use a system that parses "electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction."

The Examiner mischaracterized Applicant's argument by stating that Applicant asserts that the Sheldon patent as well as the Sheldon provisional fail to disclose how the system distinguishes between commercial suffixes and non-commercial suffixes. Applicants made no such assertion. Applicant's argument, as is explicitly stated in the heading on page 10 of the Appeal Brief, is that the provisional fails to support the disclosure in the Sheldon patent as relied upon by the Examiner as a basis for finding anticipation.

Applicants have carefully reviewed the sections cited by the Examiner as well as the entire disclosure and find no support for enabling these features. The Sheldon provisional describes storing electronic messages in a database according to prefixes, delimiters, suffixes, alphanumeric, and numeric characters specified within the address. (Page 7, 12-13) This is insufficient to support parsing emails to identify a subset comprising commercial correspondence.

The Examiner's assertion that the filtering method is applied to the suffixes and prefixes of "third-party email addresses" as disclosed on paragraph 5 of page 11 is based on a fundamental misunderstanding of Sheldon. This paragraph is not discussing the filtering of third-party email addresses. This paragraph is discussing generating an email address for the user to send to a third party and saving those emails in a hierarchical form in a directory. (Page 11, paragraphs 4-5) Thus, this paragraph is not discussing the filtering of third-party email addresses at all, but instead discusses the essence of Sheldon, which is to allow a user to have one email system that generates multiple email addresses for a user and filters emails according to the suffix email address specified by the user. (Abstract) For example, Figures 9a-b of the Sheldon patent illustrates that if the user, Sven, wants to receive newsletters, he can provide the email address sven.newsletters@suffixmail.com to newsletter service providers so that when they email a newsletter to him, it is automatically placed in the newsletter directory. (Figure 9a-b)

Furthermore, the Sheldon provisional does not teach or suggest filtering based on "commercial correspondence having commercial data related to a commercial transaction." The Sheldon provisional discusses filtering based on whether mail is of interest to the user or whether it is junk mail and filtering based on prefixes and suffixes contained in the user-generated email address. (Page 3, 11) Thus, a person skilled in the art would not know to filter emails based on the type of commercial correspondence after reading the Sheldon provisional.

B. The Third Element of Claim 1 is Not Supported by the Sheldon Provisional

The third element of claim 1 recites "program code residing on said first computer server for creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence." The Sheldon provisional does not teach or suggest these features.

In the Examiner's Answer the Examiner focuses on the use of the term "report" in the Sheldon patent and the use of the term "receipt" in the Sheldon provisional. Based on this argument, Applicants wonder if the Examiner carefully read Applicant's Appeal Brief.

Applicant does not argue that the Sheldon provisional somehow fails to enable the Sheldon patent because of the differences in the terms "receipt" and "report." Applicant discusses the use of these terms merely to describe the language used in each of these references. Applicant's argument is that the process of formatting a receipt by placing it in an email

does not enable claim 1, which discloses <u>extracting</u> commercial data to create a receipt. Extraction is a process that requires obtaining fewer pieces of information from the emails than the emails contain. Formatting a receipt to create an email, on the other hand, does not result in the loss of data. The Examiner states that the Sheldon provisional discloses generating, receiving, and extracting receipt data from third-parties on pages 25-28 and 32, but fails to explain how formatting could possibly be construed to mean extraction of data. A person skilled in the art would not know to extract commercial data from a subset of electronic messages after reading the Sheldon provisional.

Conclusion

The Sheldon provisional fails to enable the features of the Sheldon patent at issue. Thus, the Sheldon patent is not entitled to a critical reference date of February 15, 2001 for these features. Because this application was filed before the Sheldon patent, the Sheldon patent cannot be relied on as prior art for features that the Sheldon provisional does not disclose. Applicants respectfully believe that the Examiner should be reversed and ordered to pass the case to issue.

The Commissioner is authorized to charge any fees due, to the Glenn Patent Group

Deposit Account No. 07-1445, Customer No. 22862 (Attorney Docket No. OBON0004).

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